

ESTTA Tracking number: **ESTTA188378**

Filing date: **01/23/2008**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	92044571
Party	Plaintiff 200 Kelsey Associates, LLC
Correspondence Address	Edmund J. Ferdinand, III Grimes & Battersby, LLP 488 Main Avenue, Third Floor New Rochelle, CT 06851 UNITED STATES Ferdinand@gandb.com
Submission	Motion to Strike
Filer's Name	Edmund J. Ferdinand, III
Filer's e-mail	Ferdinand@gandb.com
Signature	/ejf/
Date	01/23/2008
Attachments	Ferdinand Dec Support Mot Strike.pdf (23 pages)(850289 bytes)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
TRADEMARK TRIAL AND APPEAL BOARD

-----X	:	
200 Kelsey Associates, LLC,	:	
	:	Cancellation No.: 92/044,571
Petitioner,	:	
	:	
v.	:	
	:	
One Step Up., Ltd., Successor-In-Interest	:	
to Delan Enterprises, Inc.,	:	
	:	
Respondent.	:	
-----X	:	

DECLARATION OF EDMUND J. FERDINAND, III

I, EDMUND J. FERDINAND, III, declare pursuant to 28 U.S.C. § 1746 as follows:

1. I am a Partner at Grimes & Battersby, LLP, 488 Main Avenue, Norwalk, Connecticut, counsel for Petitioner 200 Kelsey Associates, LLC in this matter. I have personal knowledge of all facts stated in this declaration and I could competently testify to the facts stated in this declaration if called to do so. I submit this declaration in support of Petitioner's Motion to Strike.

2. On October 19, 2006, I served on Registrant a First Set of Requests for Production which sought documents, *inter alia*, evidencing use of the JONATHAN LOGAN mark in commerce by Registrant or its predecessors for each year from 2000 to 2005. A true and complete copy of the First Set of Requests for Production to Registrant are attached hereto at Tab 1.

3. Registrant submitted written responses and objections to Petitioner's First Set of Requests for Production on or about January 17, 2007. A true and complete copy of Registrant's

written responses is attached hereto at Tab 2. Registrant also produced 151 pages of responsive documents at that time.

4. Discovery closed in this case on April 13, 2007.

5. Petitioner's testimony period closed on August 11, 2007.

6. Registrant's testimony period opened on September 11, 2007. On September 28, 2007, just two business days prior to the scheduled testimonial depositions of Messrs. Haigney and Adjmi on October 2, 2007, Registrant sought to serve an additional 18 pages of documents on Petitioner. Attached hereto at Tab 3 is a copy of an email communication from Registrant's counsel to the undersigned in this regard, dated September 28, 2007.

7. I immediately objected in writing to counsel's attempt to produce additional documents during Registrant's testimony period. Attached hereto at Tab 4 is a copy of my reply to counsel's email, dated September 28, 2007.

8. At the testimonial deposition of Mr. Haigney on October 2, 2007, Registrant marked as Exhibit 6 several invoices dated March, 2005. These invoices were among the documents Registrant first sent to my attention on September 28, 2007. These invoices were responsive to Petitioner's First Set of Requests for Production.

9. In addition, Registrant marked as Exhibits 7 and 8 copies of computer printouts purporting to show purchases by Burlington Coat Factory of JONATHAN LOGAN merchandise. Registrant had never served these documents on Petitioner prior to Mr. Haigney's testimonial deposition. These documents were also responsive to Petitioner's First Set of Requests for Production.

Executed on January 23, 2008.

A handwritten signature in black ink, appearing to read "Edmund J. Ferdinand, III". The signature is stylized with several horizontal strokes and a final flourish.

Edmund J. Ferdinand, III

TAB 1

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
TRADEMARK TRIAL AND APPEAL BOARD

-----X	:	
200 Kelsey Associates, LLC,	:	
	:	Cancellation No.: 92/044,571
Petitioner,	:	
	:	
v.	:	
	:	
Delan Enterprises,	:	
	:	
Registrant.	:	
-----X	:	

PETITIONER'S FIRST SET OF REQUESTS FOR PRODUCTION TO REGISTRANT

Petitioner, 200 Kelsey Associates, pursuant to Section 2.120 of the Rules of Practice in Trademark Cases and Rule 34 of the Federal Rules of Civil Procedure, hereby requests that Registrant, Delan Enterprises, within thirty (30) days from the date of service hereof, produce for inspection and copying the following documents:

DEFINITIONS and INSTRUCTIONS

A. For purposes of these requests, unless otherwise indicated or unless the context otherwise requires:

1. The term "any" shall be construed to include the word "all" and "all" shall be construed to include the word "any" as necessary to bring within the scope of a request all responses which might otherwise be construed to be outside its scope;

2. The term "between" shall be construed to include the word "among" and "among" shall be construed to include the word "between" as necessary to bring within the scope of a request all responses which might otherwise be construed to be outside its scope;

3. The terms "you" or "your" or Registrant shall refer to Delan Enterprises Incorporated and any affiliated corporations or other business entities under its control and any predecessors or successors in interest that have used the mark JONATHAN LOGAN in commerce in connection with goods in Int'l Class 25, any licensees or other entities that have used or are intended to use the mark JONATHAN LOGAN with the consent of Registrant, and any of their directors, officers, employees, agents or representatives;

4. The terms "control" or "controlled" shall mean the power or ability of an entity to direct the management and policies of any person, firm or corporation;

5. The term "document" shall mean the original and each non-identical copy (whether different from the original because of notes made on the copy or otherwise) or draft of each writing of every kind and description (together with all worksheets, supporting documents, and other relevant material), whether inscribed by hand or mechanical, electronic, microfilm, photographic or other means (such as recording, film, tape, videotape, disc, diskette, CD-ROM disc, laser disc, or other means including data processing files and other computer readable records or programs and all other data compilations from which information can be obtained, transcribed and translated), and including, but not limited to, correspondence, letters, telegrams, telefaxes, telexes, e-mail, messages, TWX's, telephone logs, diaries, teletype messages, memoranda, notes, reports, printouts, records of meetings, conferences or telephone or other conversations or communications, appointment calendars, surveys, studies, statistical analyses, technical analyses, test reports, search reports, tabulations, drawings, plans, blueprints, specifications, graphs, books, magazines, newspapers, publications, articles, booklets, pamphlets, circulars, bulletins, brochures, advertising copy, contract bids, contracts, contract addenda, amendments, changes and modifications;

6. Registrant's mark JONATHAN LOGAN shall refer to any variation thereof, whether standing alone, or as part of a unitary, compound word, composite or design mark.

B. The use of a verb in any tense shall be construed as the use of the verb in all other tenses, wherever necessary to bring within the scope of a request all responses which might otherwise be construed to be outside its scope.

C. A plural noun shall be construed as a singular noun, and a singular noun shall be construed as a plural noun, wherever necessary to bring within the scope of a request all responses which might otherwise be construed to be outside its scope.

D. Definitions provided herein apply to any grammatical variant of the term or phrase definition.

E. In the event that you contend that any document or thing asked to be produced is privileged or otherwise protected from discovery, you should specify the basis for the privilege or other ground for exclusion and produce a separate list of all such documents and things with your responses hereto. Such separate list shall identify each such document and thing by date, nature and/or type of document or thing, identity of each author(s) or creator(s) (with title and designation), identity of each recipient(s) (with title and designation), the original document/thing and/or any copies, title and subject matter of document or nature of thing, identity of each custodian and/or location of the original document, thing and/or any copies, and the grounds for such claim of privilege.

DOCUMENT REQUESTS

1. All documents evidencing use of the mark JONATHAN LOGAN in connection with women's clothing in the United States in the year 2000 by Registrant and/or its predecessors and/or successors in interest.

2. All documents evidencing use of the mark JONATHAN LOGAN in connection with women's clothing in the United States in the year 2001 by Registrant and/or its predecessors and/or successors in interest.

3. All documents evidencing use of the mark JONATHAN LOGAN in connection with women's clothing in the United States in the year 2002 by Registrant and/or its predecessors and/or successors in interest.

4. All documents evidencing use of the mark JONATHAN LOGAN in connection with women's clothing in the United States in the year 2003 by Registrant and/or its predecessors and/or successors in interest.

5. All documents evidencing use of the mark JONATHAN LOGAN in connection with women's clothing in the United States in the year 2004 by Registrant and/or its predecessors and/or successors in interest.

6. All documents evidencing use of the mark JONATHAN LOGAN in connection with women's clothing in the United States in the year 2005 by Registrant and/or its predecessors and/or successors in interest.

7. All documents evidencing use of the mark JONATHAN LOGAN in connection with women's clothing in the United States in the year 2006 by Registrant and/or its predecessors and/or successors in interest.

8. Samples of specimens evidencing use of the mark JONATHAN LOGAN in connection with women's clothing in the United States for each year from 2000 to 2006.

9. All documents referring or relating to or tending to show how the JONATHAN LOGAN mark has been marketed, advertised or promoted in the United States since 2000,

including copies of any and all brochures, print media advertisements, radio and/or television advertisements and any advertising or promotion on the Internet.

10. Documents sufficient to show advertising expenditures incurred by Registrant for the marketing, advertising and promotion of JONATHAN LOGAN brand clothing in the United States for each year from 2000 to the present.

11. Documents sufficient to show the dollar and unit volume of sales (or distribution) of clothing bearing the JONATHAN LOGAN trademark for each year from 2000 to 2006.

12. All documents and things identified in Registrant's answers to Petitioner's First Set of Interrogatories.

13. All documents related to the transfer of rights to U.S. Federal Trademark Registration Nos. 549,924 and 937651 from Delan Enterprises Incorporated to One Step Up Ltd. in or about July of 2006, including any assignment and purchase and sale documents, without limitation.

Dated: October 19, 2006

THE APPLICANT,

By: 

Edmund J. Ferdinand, III
Grimes & Battersby, LLP
488 Main Avenue, Third Floor
Norwalk, CT 06851
(203) 849-8300

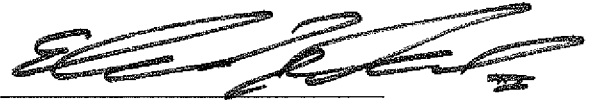
Attorneys for Applicant 200 Kelsey
Associates, LLC

CERTIFICATE OF SERVICE

This certifies that a copy of the foregoing was served on the Registrant on the date indicated below by depositing the same with the United States Postal Service as first-class mail, postage prepaid, in an envelope addressed to:

Joel Yunis, Esq.
Brett J. Danow, Esq.
Katten Muchin Rosenman, LLP
575 Madison Avenue
New York, NY 10022

Dated: October 19, 2006

A handwritten signature in black ink, appearing to read 'Edmund J. Ferdinand, III', written over a horizontal line.

Edmund J. Ferdinand, III

TAB 2

200 KELSEY ASSOCIATES, LLC : **Cancellation No.: 92/044,571**
 :
 :
 Petitioner, :
 :
 vs. :
 :
 :
 DELAN ENTERPRISES, :
 :
 :
 Registrant. :
 -----X

ONE STEP UP, LTD. as Successor-In-Interest, by Assignment, to DELAN ENTERPRISES (“Registrant”) by and through its undersigned counsel, LAZARUS & LAZARUS, P.C., as and for its Verified Responses to 200 Kelsey Associates, LLC’s (“Petitioner”) First Set of Requests for Production respectfully sets forth, represents and alleges as follows:

1. Registrant objects to the Document Requests on the ground, and to the extent that they purport to seek disclosure of information that is not specifically tailored to the relevant issues in this case, is beyond the scope of the pleadings, is palpably irrelevant to the subject matter of this action, or is not reasonably calculated to lead to the discovery of relevant admissible evidence.

2. Registrant objects to the Document Requests on the ground, and to the extent that they are over broad, unduly burdensome, oppressive, extend beyond the date of the commencement of this action or are otherwise not properly limited to the relevant time

period governing this action.

3. Registrant objects to the Document Requests on the ground, and to the extent that they are vague, ambiguous, unintelligible, or unclear.

4. Registrant objects to the Document Requests on the ground, and to the extent that they purport to seek disclosure of information that (a) is protected by the attorney-client privilege; (b) constitutes attorney work-product; (c) was prepared in anticipation of litigation, or (d) is otherwise privilege or exempt from disclosure. Any inadvertent identification or production of such documents or information shall not result in a waiver of these privileges.

5. Registrant objects to the Document Requests on the ground, and to the extent that they purport to seek disclosure of confidential or proprietary information.

6. Registrant objects to the "Instructions" and "Definitions" of the Document Requests on the ground and to the extent that they seek to expand the requirements of, or violate the applicable provisions and/or rules. Registrant further objects to the Document Requests to the extent that they seek in any way to enlarge or modify the scope of permissible discovery or to impose disclosure burdens on Registrant greater than those allowed by provisions and/or rules.

7. Registrant objects to the Document Requests on the ground, and to the extent that they seek information which is not within Registrant's possession, custody, or control, or might otherwise be obtained by Registrant from governmental or other public entities or sources.

8. Registrant's search for information and documents is ongoing and Registrant expressly reserves the right to rely on any facts, documents, or other evidence that may

develop or come to its attention at a later time during this litigation, and to supplement or amend the responses at any time prior to the trial of this action. Registrant further reserves the right to raise any additional objections deemed necessary or appropriate in light of the result of any further review.

9. Neither the fact that an objection is interposed to a particular Document Request nor the fact that no objection is interposed necessarily means that responsive information or documents exist.

10. These General Objections are specifically incorporated into the responses to each Document Requests.

II. REGISTRANT'S RESPONSES

Document Request 1. All documents evidencing use of the mark JONATHAN LOGAN in connection with women's clothing in the United States in the year 2000 by Registrant and/or its predecessors and/or successors in interest.

RESPONSE 1. See Registrant's documents Bates Stamped OSU 00001 through OSU 00131. Registrant specifically reserves the right to modify, amend and/or supplement this Response 1. Registrant further specifically reserves the right to modify, amend and/or supplement this Response 1, insofar as documents responsive hereto remain in the possession, custody or control of Registrant's predecessor-in-interest, Delan Enterprises ("Delan Enterprises").

Document Request 2. All documents evidencing use of the mark JONATHAN LOGAN in connection with women's clothing in the United States in the year 2001 by Registrant and/or its predecessors and/or successors in interest.

RESPONSE 2. See Registrant's documents Bates Stamped OSU 00001 through OSU 00131. Registrant specifically reserves the right to modify, amend and/or supplement this Response 2. Registrant further specifically reserves the right to modify, amend and/or supplement this Response 2, insofar as documents responsive hereto remain in the possession, custody or control of Delan Enterprises.

Document Request 3. All documents evidencing use of the mark JONATHAN LOGAN in connection with women's clothing in the United States in the year 2002 by Registrant and/or its predecessors and/or successors in interest.

RESPONSE 3. See Registrant's documents Bates Stamped OSU 00001 through OSU 00131. Registrant specifically reserves the right to modify, amend and/or supplement this Response 3. Registrant further specifically reserves the right to modify, amend and/or supplement this Response 3, insofar as documents responsive hereto remain in the possession, custody or control of Delan Enterprises.

Document Request 4. All documents evidencing use of the mark JONATHAN LOGAN in connection with women's clothing in the United States in the year 2003 by Registrant and/or its predecessors and/or successors in interest.

RESPONSE 4. See Registrant's documents Bates Stamped OSU 00001 through OSU 00131. Registrant specifically reserves the right to modify, amend and/or supplement this Response 4. Registrant further specifically reserves the right to modify, amend and/or supplement this Response 4, insofar as documents responsive hereto remain in the possession, custody or control of Delan Enterprises.

Document Request 5. All documents evidencing use of the mark JONATHAN LOGAN in connection with women's clothing in the United States in the year 2004 by Registrant and/or its predecessors and/or successors in interest.

RESPONSE 5. See Registrant's documents Bates Stamped OSU 00001 through OSU 00131. Registrant specifically reserves the right to modify, amend and/or supplement this Response 5. Registrant further specifically reserves the right to modify, amend and/or supplement this Response 5, insofar as documents responsive hereto remain in the possession, custody or control of Delan Enterprises.

Document Request 6. All documents evidencing use of the mark JONATHAN LOGAN in connection with women's clothing in the United States in the year 2005 by Registrant and/or its predecessors and/or successors in interest.

RESPONSE 6. See Registrant's documents Bates Stamped OSU 00001 through OSU 00131. Registrant specifically reserves the right to modify, amend and/or supplement this Response 6. Registrant further specifically reserves the right to modify, amend and/or supplement this Response 6, insofar as documents responsive hereto remain in the possession, custody or control of Delan Enterprises.

Document Request 7. All documents evidencing use of the mark JONATHAN LOGAN in connection with women's clothing in the United States in the year 2006 by Registrant and/or its predecessors and/or successors in interest.

RESPONSE 7. See Registrant's documents Bates Stamped OSU 00001 through OSU 00151. Registrant specifically reserves the right to modify, amend and/or supplement this Response 7. Registrant further specifically reserves the right to modify, amend and/or supplement this Response 7, insofar as documents responsive hereto remain in the possession, custody or control of Delan Enterprises.

Document Request 8. Samples of specimens evidencing use of the mark JONATHAN LOGAN in connection with women's clothing in the United States for each year from 2000 to 2006.

RESPONSE 8. See Registrant's documents Bates Stamped OSU 00001 through OSU 00151. Registrant specifically reserves the right to modify, amend and/or supplement this Response 8. Registrant further specifically reserves the right to modify, amend and/or supplement this Response 8, insofar as documents responsive hereto remain in the possession, custody or control of Delan Enterprises.

Document Request 9. All documents referring or relating or tending to show how the JONATHAN LOGAN mark has been marketed, advertised or promoted in the United States since 2000, including copies of any and all brochures, print media advertisements, radio and/or television advertisements and any advertising or promotion on the Internet.

RESPONSE 9. See Registrant's documents Bates Stamped OSU 00001 through OSU 00151. Registrant specifically reserves the right to modify, amend and/or supplement this Response 9. Registrant further specifically reserves the right to modify, amend and/or supplement this Response 9, insofar as documents responsive hereto remain in the possession, custody or control of Delan Enterprises.

Document Request 10. Documents sufficeint to show advertising expenditures incurred by Registrant for the marketing, advertsiing and promotion of JONATHAN LOGAN brand clothing in the United States for each year from 2000 to the present.

RESPONSE 10. See Registrant's documents Bates Stamped OSU 00001 through OSU 00151. Registrant specifically reserves the right to modify, amend and/or supplement this Response 10. Registrant further specifically reserves the right to modify, amend and/or supplement this Response 10, insofar as documents responsive hereto remain in the possession, custody or control of Delan Enterprises. Registrant will supply additional documents as they become available.

Document Request 11. Documents sufficeint to show the dollar and unit volume of sales (or distribution) of clothing bearing the JONATHAN LOGAN trademark for each year from 2000 to 2006.

RESPONSE 11. See Registrant's documents Bates Stamped OSU 00001 through OSU 00151. Registrant specifically reserves the right to modify, amend and/or supplement this Response 11. Registrant further specifically reserves the right to modify, amend and/or supplement this Response 11, insofar as documents responsive hereto remain in the possession, custody or control of Delan Enterprises. Registrant will supply additional documents as they become available.

Document Request 12. All documents and things identified in Registrant's answer to Petitioner's First Set of Interrogatories.

RESPONSE 12. See Registrant's documents Bates Stamped OSU 00001 through OSU 00151. Registrant specifically reserves the right to modify, amend and/or supplement this Response 12. Registrant further specifically reserves the right to modify, amend and/or supplement this Response 12, insofar as documents responsive hereto remain in the possession, custody or control of Delan Enterprises.

Document Request 13. All documents relating to the transfer of rights to U.S. Federal Trademark Registration Nos. 549,924 and 937651 from Delan Enterprises Incorporated to One Step Up Ltd. In or about July of 2006, including any assignment and purchase and sale documents, without limitation.

RESPONSE 13. See Registrant's documents Bates Stamped OSU 00141 through OSU 00151.

Respectfully submitted this 17th day of January, 2007.

LAZARUS & LAZARUS, P.C.

Attorneys for Registrant

ONE STEP UP, LTD. as Successor-In-Interest

By Assignment to DELAN ENTERPRISES

By: _____

HARLAN M. LAZARUS {HML-0268}

240 Madison Avenue, 8th Flr.

New York, New York 10016

Tel. (212) 889-7400

To: GRIMES & BATTERSBY, LLP

Attorneys for Petitioner 200 KELSEY ASSOCIATES, LLC

488 Main Street, Third Floor

Norwalk, Connecticut 06851

Tel. (203) 849-8300

Attention: **EDMUND J. FERDINAND, III, ESQ.**

IN THE UNITED STATE PATENT AND TRADEMARK OFFICE
TRADEMARK TRIAL AND APPEAL BOARD

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200 KELSEY ASSOCIATES, LLC	: Cancellation No.: 92/044,571
	:
Petitioner,	:
vs.	:
	:
DELAN ENTERPRISES,	: <u>VERIFICATION</u>
	:
Registrant.	:
-----X	

HARRY ADJMI, being duly sworn, deposes and says:

I am the President of One Step Up, Ltd., Successor-In Interest, by Assignment, to DELAN ENTERPRISES, REGISTRANT, in the within action and I have read the foregoing Responses to Petitioner's First Set of Requests For Production and know the contents thereof; and the same is true to my own knowledge, except as to the matters therein stated to be alleged upon information and belief; and as to the matters I believe to be true.

Harry Adjmi, President, One Step Up, Ltd., Successor-In-Interest,
By Assignment, To Delan Enterprises, Registrant

Sworn to before me this day of January, 2007

Notary Public

TAB 3

Jed Ferdinand

From: carissalaz@aol.com
Sent: Friday, September 28, 2007 11:17 AM
To: ferdinand@gandb.com
Cc: hmlaw@att.net
Subject: JONATHAN LOGAN
Attachments: OSU152-168.pdf

Mr. Ferdinand:

Per Harlan's request, attached hereto please find One Step Up's document production bates stamped OSU152 - OSU168.

Please let me know if you have difficulty opening the documents. Thanks.

Very Truly Yours,
Carissa Schumacher
Paralegal
LAZARUS & LAZARUS P.C.

Email and AIM finally together. You've gotta check out free [AOL Mail!](#)

TAB 4

Current Folder: **Sent**[Sign Out](#)[Compose](#) [Addresses](#) [Folders](#) [Options](#) [Search](#) [Help](#)[SquirrelMail](#)[Message List](#) | [Delete](#) | [Edit Message](#)
[as New](#)[Previous](#) | [Next](#)[Forward](#) | [Forward as Attachment](#) | [Reply](#) | [Reply All](#)**Subject:** Re: JONATHAN LOGAN**From:** ferdinand@gandb.com**Date:** Fri, September 28, 2007 4:19 pm**To:** carissalaz@aol.com**Cc:** ferdinand@gandb.com ([more](#))**Priority:** Normal**Options:** [View Full Header](#) | [View Printable Version](#)

Harlan:

You can't serve documents during trial. The discovery cut-off was long ago. To the extent you seek to offer any of these documents into evidence during your testimony period, I will object on timeliness grounds and am extremely confident they will all get excluded by the Board (I have raised this same objection successfully in prior cases).

Plus, as a separate consideration my emails were for settlement purposes and will likewise be excluded on that ground.

Jed Ferdinand

> Mr. Ferdinand:

>

> Per Harlan's request, attached hereto please find One Step Up's document
> production bates stamped OSU152 - OSU168.?

>

> Please let me know if you have difficulty opening the documents.? Thanks.

>

>

> Very Truly Yours,

> Carissa Schumacher

> Paralegal

> LAZARUS & LAZARUS P.C.

>

>

> Email and AIM finally together. You've gotta check out free AOL Mail! -

> <http://mail.aol.com>

>

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